

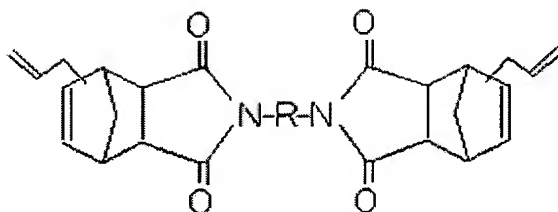
claims. As pointed out in M.P.E.P. §2113, in examining a product-by-process claim, weight must be given to the structure implied by the process steps.

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where ... the manufacturing process steps would be expected to impart distinctive structural characteristic to the final product. (MPEP, Rev. 3, August 2005, §2113)

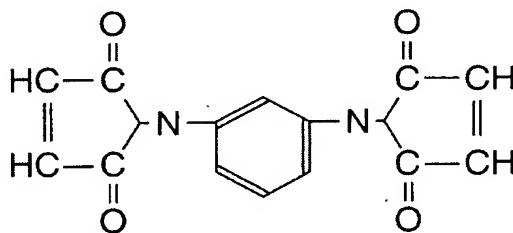
See also, *In re Garnero*, 412 F.2d 267, 279, 162 USPQ 221, 223 (CCPA 1979).

The process steps of dispersing bisallylnadiimide and other ingredients in a solvent to prepare a second coating solution and applying and drying the second coating solution recited in claims 1-6 would necessarily and inherently impart a distinctive structural characteristic to the resulting coated fibers, namely the presence of bisallylnadiimide or a polymerization product thereof. This structural characteristic is not present in the fibers of Akiyama. Claim 7 defines a coating solution which necessarily contains bisallylnadiimide, and Akiyama does not describe any such solution. Thus, claims 1-7 clearly distinguish over Akiyama, and the §102(b) rejection cannot stand.

Method claims 8-13 also expressly recite among other steps the steps of dispersing bisallylnadiimide and other ingredients in a solvent to prepare a second coating solution and applying and drying the second coating solution. The Final Action rejected these claims under 35 U.S.C. §103(a) over Akiyama for the reasons of record. The original rejection acknowledged that Akiyama does not disclose the claimed bisallylnadiimide, but alleged that use of the claimed bisallylnadiimide would have been obvious from Akiyama's use of a maleimide. Applicants respectfully disagree. Applicants' claimed bisallylnadiimide is structurally distinct from Akiyama's maleimide. The claimed bisallylnadiimide corresponds to the following formula:



In contrast, Akiyama's maleimide corresponds to the formula:



These compounds are structurally distinct, and there is no suggestion or motivation in the record which would lead a person of ordinary skill in the art to modify the process of Akiyama to use the claimed structurally distinct bisallylnadiimides instead of the disclosed maleimide. Thus, Akiyama fails to make out a proper *prima facie* case of obviousness, and the §103 rejection cannot stand.

Moreover, even assuming *arguendo* that a *prima facie* case of obviousness had been made out, it would be effectively rebutted by the unexpected superior results achieved by the claimed bisallylnadiimide as set forth in Table 1 on page 10 of the specification which reports the results of a comparative test of the use of bisallylnadiimide (Example 1) verses the use of N,N'-(m-phenylene)dimaleimide as taught by Akiyama. (Comparative Example 3) and shows that the bisallylnadiimide unexpectedly and surprisingly achieves much better adhesion strength than the maleimide. See *In re Margolis*, 228 USPQ 940 (Fed. Cir. 1986).

In view of the foregoing, the application is respectfully submitted to be in condition for allowance, and prompt, favorable action thereon is earnestly solicited.


Application No. 10/761,418
Reply to Final Office Action
March 20, 2006

If there are any questions regarding this Reply or the application in general, a telephone call to the undersigned at (202) 624-2845 would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #038788.53188US).

Respectfully submitted,

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J. D. Evans
Registration No. 26,269

CROWELL & MORING LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JDE:moi